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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 10

Application Number: 09/504,978
Filing Date: February 15, 2000
Appellant(s): OHRT

Marc R. Ascolese
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 1, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-15 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 16-23 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 1-15 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 16-23 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,523,942	Tyler et al.	06-1996
5,689,650	McClelland et al.	11-1997
6,026,404	Adunuthula et al.	02-2000
5,918,022	Batz et al.	06-1999
5,689,664	Narayanan et al.	11-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-23 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Actions, Papers No. 5 and 7 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Actions (Papers No. 5 and 7). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office actions, Papers 5 and 7.

1. Claims 1-3, 5, 6, 12-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler, Jr. et al., U.S. Patent Number 5, 523, 942 in view of McClelland et al, U.S. Patent Number 5, 689, 650.

(A) As per claim 1, Tyler teaches a product rate calculation system (Tyler; column 4, line 65 to column 5, line 10) comprising:

a product application operable to provide product information to and receive consumer information from a user (Tyler; column 5, lines 32-41), and further operable to send a call to a product rate calculation software component (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36);

a first support software component operable to receive the call from the product application (Tyler; column 5, lines 18-32).

Tyler fails to explicitly disclose a first protocol stack operable to process the call into a protocol for transmission over a communication link.

McClelland teaches a first protocol stack operable to process the call into a protocol for transmission over a communication link (McClelland; column 20, line 65 to column 21, line 19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the product rate calculation system of Tyler to include a first protocol stack operable to process the call into a protocol for transmission over a communication link, as taught by McClelland, with the motivation of providing a user interface for the network serving as a link between a requesting user and the fulfillment source (McClelland; column 4, lines 46-49).

(B) As per claims 2-3, 5, Tyler and McClelland teach a system discussed above wherein being operable to send a call to a product rate calculation software component further comprises being operable to send at least one pointer to a product rate calculation software component interface (Tyler; Figure 11, column 11, lines 33-36, column 20, lines 48-54, 65-67, column 21, lines 1-5, column 22, lines 37-40, column 23, lines 25-36) and wherein the at least one pointer indicates rating information stored in a database (Tyler; Figures 3A-3D, Figure 12, Item 750, column 15, lines 13-26, column 30, lines 27-32, column 29, lines 62-64, column 22, lines 37-40, column 23, lines 25-36), and wherein the product application further comprises at least one product application software component (Tyler; column 7, lines 39-54).

(C) As per claim 6, Tyler and McClelland teach a system discussed above wherein the protocol stack is a network protocol stack (Tyler; Figure 1A, Item 5, column 7, lines 8-14, column 10, lines 48-53).

(D) As per claims 12-13, Tyler and McClelland teach a system discussed above wherein the product application is an insurance product application and the product information includes an insurance product rate and wherein the insurance product rate is for one of home insurance, life insurance, health insurance, automobile insurance, and renter's insurance. (Tyler; column 1, lines 15-24).

(E) As per claim 14, Tyler and McClelland teach a system discussed above wherein at least one of the product application, the first support software component, and the first protocol stack is encoded in a computer readable medium as instructions executable on a processor, the computer readable medium being one of an electronic storage medium, a magnetic storage medium, an optical storage medium, and a communications medium conveying signals encoding the instructions (Tyler; column 4, line 65 to column 5, line 32).

(F) As per claim 15, Tyler and McClelland teach a system discussed above further comprising a computer system including a processor, a memory coupled to the processor (Tyler; column 6, lines 66-67), and a network interface (Tyler; column 7, lines 4-14), and wherein the product application, the first support software component, and the first protocol stack are encoded as instructions executable on the processor (Tyler; column 4, line 65 to column 5, line 32).

(G) Claim16 differs from claim 1 in that it is a method of calculating a product rate rather than a product rate calculation system.

As per claim 16, Tyler teaches a method of calculating a product rate (Tyler; column 4, line 65 to column 5, line 10) comprising:

receiving a request for a product rate from a user (Tyler; column 5, lines 32-41);

converting the request for a product rate into a call to a product rate calculation software component (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36);

sending the call to a product rate calculation software component to a first support software component (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36);

receiving, at the first support software component, the call to a product rate calculation software component (Tyler; column 5, lines 18-32);

and

transmitting the call to a product rate calculation software component over the communication link (Tyler; Figure 1A, Item 5, column 7, lines 8-14, column 10, lines 48-53).

Tyler fails to expressly disclose processing the call to a product rate calculation software component into a protocol for transmission over a communication link.

McClelland teaches processing the call to a product rate calculation software component into a protocol for transmission over a communication link. (McClelland; column 20, line 65 to column 21, line 19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the product rate calculation system of Tyler to include processing the call to a product rate calculation software component into a protocol for transmission over a communication link, as taught by McClelland, with the motivation of providing a user interface

for the network serving as a link between a requesting user and the fulfillment source (McClelland; column 4, lines 46-49).

(H) As per claims 17-19, Tyler and McClelland teach a method discussed above, further comprising:

receiving the transmitted call to a product rate calculation software component (Tyler; column 5, lines 18-32);

processing the transmitted call to a product rate calculation software component (Tyler; Figure 1A, Item 5, column 7, lines 8-14, column 10, lines 48-53);

sending the processed call to a second support software component (Tyler; Figure 1A, Item 5, column 7, lines 8-14, column 10, lines 48-53)

receiving, at a second support software component, the call to a product rate calculation software component (Tyler; column 5, lines 18-32);

sending the call to a product rate calculation software component to a product rate calculation software component interface (Tyler; column 5, lines 5-10); and

performing a product rate calculation depending upon rating information (Tyler; column 20, lines 55-64), and retrieving rating information from a database (Tyler; Figures 3A-3D, column 15, lines 13-26, column 30, lines 27-32, column 29, lines 62-64, column 22, lines 37-40, column 23, lines 25-36), and further comprising storing a calculated product rate in a database (Tyler; Figure 12, Item 750, Figure 18).

(I) As per claim 20, Tyler and McClelland teach a method discussed above wherein the receiving a request further comprises receiving consumer information from a computer

system (Tyler; Figures 2, 3A-3D, Figure 12, Item 750, column 15, lines 13-26, column 30, lines 27-32, column 29, lines 62-64, column 22, lines 37-40, column 23, lines 25-36).

(J) As per claim 21, Tyler and McClelland teach a method discussed above encoded in a computer readable medium as instructions executable on a processor, the computer readable medium being one of an electronic storage medium, a magnetic storage medium, an optical storage medium, and a communications medium conveying signals encoding the instructions (Tyler; column 4, line 65 to column 5, line 32).

(K) As per claim 22, Tyler and McClelland teach a method discussed above wherein sending the call to a product rate calculation software component to a first support software component further comprises sending at least one pointer the to a product rate calculation software component interface (Tyler; Figure 11, column 11, lines 33-36, column 20, lines 48-54, 65-67, column 21, lines 1-5, column 22, lines 37-40, column 23, lines 25-36).

(L) As per claim 23, Tyler and McClelland teach a method discussed above wherein the product rate is an insurance product rate (Tyler; column 1, lines 15-24).

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 in view of McClelland et al, U.S. Patent Number 5, 689, 650 as applied to claim 1 above, and further in view of Adunuthula et al, U.S. Patent Number 6, 026, 404.

(A) As per claim 4, Tyler and McClelland fail to expressly disclose a system discussed above wherein the product application and the first support software component execute in a single process.

Adunuthula teaches a system wherein the product application and the first support software component execute in a single process (Adunuthula; column 14, lines 64-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the product rate calculation system of Tyler and McClelland to include a product application and the first support software component execute in a single process, as taught by Adunuthula, with the motivation of isolating the software from the complexities of inter-machine communication and allowing its use in a highly distributed system without being distribution aware (Adunuthula; column 15, lines 12-21).

3. Claims 7, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 in view of McClelland et al, U.S. Patent Number 5, 689, 650 as applied to claim 1 above, and further in view of Batz et al, U.S. Patent Number 5, 918, 022.

(A) As per claims 7, 9, Tyler and McClelland teach a system as analyzed and disclosed above, further including

a product rate calculation software component (Tyler; column 4, line 65 to column 5, line 10) having a product rate calculation software component interface (Tyler; column 5, lines 5-10),

the product rate calculation software component for calculating a product rate depending upon rating information (Tyler; Figures 3A-3D, Figure 12, Item 750, column 15, lines 13-26,

column 30, lines 27-32, column 29, lines 62-64, column 22, lines 37-40, column 23, lines 25-36); and

a second support software component (Tyler; column 4, lines 10-24).

Tyler and McClelland fail to expressly disclose a system further comprising:

a second protocol stack; and

a communication link coupled between the first protocol stack and the second protocol stack, the second protocol stack operable to receive and process a transmission from the first protocol stack into a call to a software component

and wherein the communication link is a network.

Batz teaches a system including:

a second protocol stack; (Batz; Figure 1, Items 125 and 175, column 1, lines 43-54, column 2, lines 31-40) and

a communication link coupled between the first protocol stack and the second protocol stack, (Batz; Figure 1, Item 180) the second protocol stack operable to receive and process a transmission from the first protocol stack into a call to a software component (Batz; Figure 9, Item 900, column 3, line 60 to column 4, line 2, column 10, lines 36-44)

and wherein the communication link is a network (Batz; Figure 2, column 2, lines 31-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the product rate calculation system of Tyler and McClelland to include a second protocol stack; and a network communication link coupled between the first protocol

stack and the second protocol stack operable to receive and process a transmission from the first protocol stack into a call to a software component, as taught by Batz, with the motivation of using modern communications network architectures to transport data over a TCP/IP network (Batz; column 1, lines 44-47).

(B) As per claim 11, Tyler and McClelland teach a system as analyzed and disclosed above,

wherein the rating information includes at least one of consumer information and product information (Tyler; Figures 2, 3A-3D, Figure 12, Item 750, column 15, lines 13-26, column 30, lines 27-32, column 29, lines 62-64, column 22, lines 37-40, column 23, lines 25-36).

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 and McClelland et al, U.S. Patent Number 5, 689, 650 in view of Batz et al, U.S. Patent Number 5, 918, 022, as applied to claim 7 above, and further in view of Narayanan , et al, U.S. Patent Number 5, 689, 664.

(A) As per claim 8, Tyler, McClelland , and Batz teach a system as analyzed and disclosed above.

Tyler, McClelland , and Batz fail to expressly disclose a system wherein the first support software component is a proxy component and the second support software component is a stub component.

Narayanan teaches a system wherein the first support software component is a proxy component and the second support software component is a stub component (Narayanan; Figures 2, 4, column 4, lines 21-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the product rate calculation system of Tyler, McClelland, and Batz to include the first support software component as a proxy component and the second support software component as a stub component, as taught by Narayanan, with the motivation of centralizing the processing and saving system resources (Narayanan; column 3, lines 55-67).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler et al, U.S. Patent Number 5, 523, 942 and McClelland et al, U.S. Patent Number 5, 689, 650 in view of Batz et al, U.S. Patent Number 5, 918, 022, as applied to claim 7 above, and further in view of Adunuthula et al, U.S. Patent Number 6, 026, 404.

(A) As per claim 10, Tyler, McClelland, and Batz teach a system as analyzed and disclosed above.

Tyler, McClelland, and Batz fail to expressly disclose a system wherein the product rate calculation software component and the second support software component execute in a single process.

Adunuthula teaches a system wherein the product application and the second support software component execute in a single process (Adunuthula; column 14, lines 64-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the product rate calculation system of Tyler, McClelland, and Batz to include a product application and the second support software component execute in a single process, as taught by Adunuthula, with the motivation of isolating the software from the

complexities of inter-machine communication and allowing its use in a highly distributed system without being distribution aware (Adunuthula; column 15, lines 12-21).

(11) Response to Argument

In the Appeal Brief filed December 1, 2003, Appellant makes the following argument:

(A) Claims 1-15 are not properly rejected under 35 USC § 112.

(B) Claims 16-23 are not properly rejected under 35 USC § 112.

(C) The applied references do not show or suggest limitations in claims 1-15.

(D) The applied references do not show or suggest limitations in claims 16-23.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

A. Group I:

In response to Appellant's assertion that claims 1-15 are not properly rejected under 35 USC § 112, Examiner notes that, according to MPEP § 2172.01, "a claim which fails to interrelate essential elements of the invention as defined by Applicant (s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968)." MPRP continues to explain "the primary

purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what Applicant s regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention."

In this regard, Examiner respectfully notes that claim 1 recites a "product rate calculation system" in its preamble, but only recites three elements in its body, namely a "product application", a " first support software component" and a "first protocol stack". It is unclear as to which element performs the "rate calculation" function recited in the preamble. Simply stated, does the claimed product application or the claimed first support software component or the claimed first protocol stack perform the act of "product rate calculation", or is there another element responsible for this function? It is unclear whether or not product rate calculation is an integral part of the system for which Appellant seeks patent protection. As such, the claim, as presently recited, appears to be incomplete.

B. Group II:

In response to Appellant's assertion that claims 16-23 are not properly rejected under 35 USC § 112, Examiner notes that, according to MPEP § 2172.01, "a claim which fails to interrelate essential elements of the invention as defined by Applicant (s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly

claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968)." MPRP continues to explain "the primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what Applicant s regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention."

In this regard, Examiner respectfully notes that claim 16 recites a "method calculating a product rate" in its preamble, but recites six steps in its body, namely "receiving a request", "converting the request... into a call", "sending the call", "receiving the call", "processing the call ... into a protocol for transmission", and "transmitting the call". It is unclear as to which step performs the "calculating product rate" function recited in the preamble. Simply stated, does the claimed receiving a request step or the claimed converting step or the claimed sending step or the claimed receiving step or the claimed processing step or the claimed transmitting step expressly perform the act of "calculating a product rate", or is there another element responsible for this function? It is unclear whether or not product rate calculation is an integral part of the method for which Appellant seeks patent protection. As such, the claim, as presently recited, appears to be incomplete.

C. Group III:

In response to Appellant's assertion that the applied references, do not show or suggest limitations in claims 1-15 of Appellant's invention, all of the limitations which Appellant disputes are missing in the applied references, including a product rate calculation system including a product application operable to provide product information to and receive consumer information from a user, and further operable to send a call to a product rate calculation software component and a first support software component operable to receive the call, and a first protocol stack operable to process the call have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Tyler, McClelland, Adunuthula, Batz, and Narayanan, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the cited sections of the prior Office Actions (papers number 5 and 7), and as noted above, and incorporated herein. Further reasons appear hereinbelow.

In particular, Examiner notes the cited references teach all the limitations of claim 1, including the limitations of "a product application operable to provide product information to and receive consumer information from a user" (Tyler; column 5, lines 32-41) and "further operable to send a call to a product rate calculation software component" (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36) and further including "a first support software component operable to receive the call from the product application" (Tyler; column 5, lines 18-32) in addition to teaching a first protocol stack operable to process the call into a protocol for transmission over a communication link (McClelland; column 20, line 65 to column 21, line 19).

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Examiner respectfully notes that the cited portions of Tyler, including the text quoted by Appellant at the paragraph bridging pages 9 and 10 in the Appellant's Brief, explicitly relate to the claim limitations, detailing both the information being sent and the information being received.

In particular, the first part of the first element of claim 1 recites, " a product application operable to provide product information to and receive consumer information from a user ...". The cited portion of Tyler (column 5, lines 32-41) states the following:

> "Typical functions that can be performed by the present invention include: (i) collecting information required to design an insurance product for a customer; (ii) receiving a request for information about an insurance product or policy; (iii) accessing stored information, such as rates, performing the necessary calculations based on the request and returning the requested information to the user; and (iii) displaying policy level and component level information at both a "point in time" and over one or more time intervals."

This passage clearly establishes: (i) insurance product information is requested by a customer (i.e., "user"); (ii) calculations are based on the request (i.e., the user's request data includes consumer information necessary for calculations); and (iii) the requested information is returned to the user (i.e., insurance product information is provided to the user).

Given the clear and unmistakable teaching of the applied reference, as identified above, the Examiner fails to see how or why Appellant regards the citation of specific portions of the applied reference that directly correspond to uniquely identified passages of claimed limitations as designations that are not "nearly as practicable" and the pertinence of the reference "not clearly explained." Rather, the Examiner respectfully submits that Appellant has failed to point to any specific distinction(s) between Tyler's "receiving a request for information about an insurance product or policy...accessing stored information ... performing the necessary calculations... and returning the requested information to the user" and the presently claimed "a product application operable to provide product information to and receive consumer information from a user."

In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Applicant 's recited product rate calculation system including a product application operable to provide product information to and receive consumer information from a user and further operable to send a call to a product rate calculation software component, a first support software component operable to receive the call, a first protocol stack operable to process the call, and the corresponding elements of the Tyler and McClelland references? Also, arguments or conclusions of Attorney cannot take the place of evidence. In *re Cole,* 51 CCPA 919, 326 F.2d

769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

As per Appellant's argument that "none of the things to which Examiner refers as teaching the claimed product application are operable to call Calculation Engine 16," the Examiner respectfully submits that Appellant has apparently overlooked the clear and unmistakable teaching of Tyler. In particular, in the passage repeatedly referred to by the Examiner, column 11, lines 33-36, Tyler states:

> "API Layer 14 allows the Calculation Engine 16 **to be called** by multiple applications (i.e., consumer applications which do not employ object oriented technologies) **to input and/or retrieve data into and from the Calculation Engine** 16" (emphasis added).

As such, it appears Appellant's allegations are without support in that (i) Appellant's allegation that Tyler's Calculation Engine 16 is not "operable to be called" is clearly contradictory to Tyler's teachings; and (ii) Appellant fails to provide any logical or scientific reasoning why Appellant regards the aforementioned passage as lacking a component operable to receive from/send a call to Tyler's Calculation Engine (16).

Furthermore, as per Appellant's contention that the Examiner has failed to identify a "first support software component operable to receive the call," the Examiner respectfully submits that Appellant appears to consider ONLY the cited passages of Tyler in a vacuum, without properly considering the full teachings of the applied reference. For example, as noted above, column 11, lines 33-36 of Tyler explicitly indicates that multiple software applications (consumer applications) call the calculation engine 16. Many other passages of Tyler indicate various embodiments of a "first support software component." For example, column 8, lines 7-10 states:

"The API enables the calculation engine to be accessed by both personal computer-based and mainframe-based computer platforms via user interfaces such as, but not limited to, the design grid."

This passage clearly establishes a design grid (element 10; column 11, lines 5-36 of Tyler) to be one embodiment of a "first support software component." Further, given the fact that Appellant's specification provides no specific definition for the claimed "first support software component," the Examiner respectfully submits that, when given its broadest reasonable interpretation, this element is met by any and every software component "operable to receive" a call to a product rate calculation software. As such, it is readily apparent that Tyler teaches such a component in reciting a number of software applications operable to call and receive calls from a Calculation Engine 16.

In response to Appellant's argument that there is no suggestion to combine the references, and that Examiner "simply reiterates the same purported motivation," the Examiner notes that the motivations for combining the applied references can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant application the motivations have been found in the references themselves. For example, the Examiner noted that motivation to combine Tyler and McClelland, was that of providing a user interface for the network serving as a link between a requesting user and the fulfillment source, which is taken solely from the teachings of McClelland (column 4, lines 46-49).

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

D. Group IV:

In response to Appellant's assertion that the applied references, do not show or suggest limitations in claims 16-23 of Appellant's invention, all of the limitations which Appellant disputes are missing in the applied references, including receiving a request for a product rate from a user, converting the request for a product rate into a call to a product rate calculation software component, sending the call to a product rate calculation software component to a first support software component, receiving, at the first support software component, the call to a product rate calculation software component, transmitting the call to a product rate calculation

software component over the communication link, and processing the call to a product rate calculation software component into a protocol for transmission over a communication link have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Tyler, McClelland, Adunuthula, Batz, and Narayanan, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the cited sections of the prior Office Actions (papers number 5 and 7), and as noted above, and incorporated herein. Further reasons appear hereinbelow.

In particular, Examiner notes the cited references teach all the limitations of claim 16, including the limitations of "receiving a request for a product rate from a user" (Tyler; column 5, lines 32-41) and "converting the request for a product rate into a call to a product rate calculation software component" (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36) and further including "sending the call to a product rate calculation software component to a first support software component" (Tyler; Figure 1B, column 5, lines 11-18, column 11, lines 33-36) in addition to teaching "receiving, at the first support software component, the call to a product rate calculation software component" (Tyler; column 5, lines 18-32) and "transmitting the call to a product rate calculation software component over the communication link" (Tyler; Figure 1A, Item 5, column 7, lines 8-14, column 10, lines 48-53) and "processing the call to a product rate calculation software component into a protocol for transmission over a communication link" (McClelland; column 20, line 65 to column 21, line 19).

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited

in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Examiner respectfully notes that the cited portions of Tyler, including the text quoted by Appellant at the paragraph bridging pages 17 and 18 in the Appellant's Brief, explicitly relate to the claim limitations, detailing the sending, receiving, processing and transmitting of calls to the product rate calculation software. In particular, the first part of the first element of claim 16 recites, "receiving a request for a product rate from a user ...". The cited portion of Tyler (column 5, lines 32-41) states the following:

> "Typical functions that can be performed by the present invention include: (i) collecting information required to design an insurance product for a customer; (ii) receiving a request for information about an insurance product or policy; (iii) accessing stored information, such as rates, performing the necessary calculations based on the request and returning the requested information to the user; and (iii) displaying policy level and component level information at both a "point in time" and over one or more time intervals."

This passage clearly establishes: (i) insurance product information is requested by a customer (i.e., "user"); (ii) calculations are based on the request (i.e., the user's request data includes consumer information necessary for calculations); and (iii) the requested information is returned to the user (i.e., insurance product information is provided to the user).

Given the clear and unmistakable teaching of the applied reference, as identified above, the Examiner fails to see how or why Appellant regards the citation of specific portions of the applied reference that directly correspond to uniquely identified passages of claimed limitations

as designations that are not "nearly as practicable" and the pertinence of the reference "not clearly explained." Rather, the Examiner respectfully submits that Appellant has failed to note the distinctions between Tyler's "receiving a request for information about an insurance product or policy...accessing stored information ... performing the necessary calculations... and returning the requested information to the user" and the presently claimed "receiving a request for a product rate from a user, converting the request for a product rate into a call to a product rate calculation software component, sending the call to a product rate calculation software component to a first support software component, receiving, at the first support software component, the call to a product rate calculation software component, transmitting the call to a product rate calculation software component over the communication link, and processing the call to a product rate calculation software component into a protocol for transmission over a communication link"

In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Appellant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Appellant's recited method of calculating a product rate including receiving a request for a product rate from a user, converting the request for a product rate into a call to a product rate calculation software component, sending the call to a product rate calculation software component to a first support software component, receiving, at the first support software component, the call to a product rate calculation software component, transmitting the call to a

product rate calculation software component over the communication link, and processing the call to a product rate calculation software component into a protocol for transmission over a communication link, and the corresponding elements of the Tyler and McClelland references? Also, arguments or conclusions of Attorney cannot take the place of evidence. In *re Cole,* 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze,* 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick,* 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In response to Appellant's argument that there is no suggestion to combine the references, and that Examiner "simply reiterates the same purported motivation," the Examiner notes that the motivations for combining the applied references can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant application the motivations have been found in the references themselves. For example, the Examiner noted that motivation to combine Tyler and McClelland, was providing a user interface for the network serving as a link between a requesting user and the fulfillment source, which is taken solely from the teachings of McClelland (column 4, lines 46-49).

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has

been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.

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